

REMARKS

In this application, claims 1-42 are pending. In the pending Office Action, Examiner Blanco made an election requirement, which he characterized as follows:

- I. Fusion Implant
 - Species A: Having no pin
 - Species B: Having pin; shape of pin is tapered
 - Species C: Having pin; angle of insertion of pin is oblique
- II. Number of Bone Pieces
 - Species A: Two pieces
 - Species B: Three pieces
 - Species C: Four pieces

The above language concerning the examiner's categorization is taken verbatim from the Office Action for the sake of clarity, and is not intended as an admission of any sort by Applicants as to the subject matter of any claim.

Initially, it is respectfully submitted that the election requirement is too unclear for Applicant to make a reasoned and proper response. Based on prior experience with the Patent and Trademark Office, it would appear that the election requirement establishes three species (A, B and C) from which to choose. Species A, for example, includes "having a pin" and "two [bone] pieces." However, that formulation does not address all of the disclosure and claims of this application, and using it thus results in an election requirement that does not properly assess the subject matter of this application. It may be possible that the election requirement seeks a choice of one selection from each category, i.e. one "fusion implant" selection and one "bone piece" selection. That formulation also does not appear to be appropriate at least because the elements identified by the examiner are not mutually exclusive, and claims including the respective elements overlap. See MPEP 806.04(I). Thus, subject matter having a pin with a tapered shape can be obliquely angled, and subject matter having four bone pieces, by definition,

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must have three bone pieces and two bone pieces. Since the election requirement is not clear as to what is being requested, making a fully-informed response impossible, and since the more likely interpretation of it is not sanctioned by the MPEP, it should be withdrawn.

The election requirement relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, in requesting that Applicant elect a single species. The Examiner added his opinion that no claims are generic. Section 121 permits limitation to a "reasonable number" of species. The embodiments shown and described in this application are a reasonable number for consideration, and the election requirement does not suggest otherwise. Further, the similarities among the embodiments are such that they can all be efficiently considered together when the claims are searched and examined. The rationale stated in MPEP 803 and 808.02 in the context of restriction, that an application should be examined as a whole if it can be done without undue burden on the examiner, should be applied in this case as well. On at least these legal and practical bases, the election requirement should be withdrawn.

The Examiner has further requested a listing of the pending claims that read on the provisionally-elected species. That request is respectfully objected to as improperly devolving the responsibilities of the PTO onto the Applicants. The PTO has the burden of proof to provide evidence and a sufficient showing that claims in an application are unpatentable, or should otherwise be excluded from an application.

Bearing in mind the ambiguousness of the election requirement, yet wishing to give as complete a response as is possible, Applicant chooses to provisionally elect the "tapered pin" and "two bone pieces" aspects noted in the election requirement, with traverse. Given the breadth of the specification and the claims, at least claims 1-8, 15-30, 35-36, 38-39, and 41-42 read on that subject matter. Further, claims 1-8, 15-30, 35-36, 38-39, and 41-42 of this application are

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generic to and read on at least the alleged species having a pin and any of the numbers of bone pieces noted in the election requirement. Applicants do not concede the propriety of the Examiner's request, and do not intend to limit in any way the scope of the claims or this application with the statements herein. Applicants reserve the right to later assert that other claims read on that embodiment as well, especially if the election requirement is not withdrawn.

Traversal is based on the ambiguousness of the election requirement, its categorization of overlapping subject matter (MPEP 806.04(f)), the fact that there is no showing that the alleged species constitute an unreasonable number, the lack of significant extra burden on the examiner in examining all claims, and the genericness of many of the presented claims to several of the alleged species. For at least these reasons, the election requirement should be withdrawn, and all claims should be examined.

No amendments have been made to the claims in this paper. The claims are intended to have the full scope permitted by their language.

In conclusion, Applicant has provisionally elected the "tapered pin" and "two bone pieces" aspects noted in the election requirement, with traverse. Examiner Blanco is respectfully requested to reconsider the present election requirement and withdraw it. An Office Action toward a Notice of Allowance in this case is respectfully solicited.

Respectfully submitted,



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